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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,972	07/31/2002	Stefan Rychlak	10191/2264	4847
26646	7590	02/21/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			TO, TUAN C	
			ART UNIT	PAPER NUMBER
			3663	

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/070,972	Applicant(s) RYCHLAK, STEFAN	
	Examiner Tuan C. To	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brunts et al. (U.S. 5887269A) and in view of Nimura et al. (US 5884218A).

With respect to claims 11, and 16, Brunts et al. discloses a memory card (120) (Bruns et al, figure 8), which is about the size of a credit card and is formatted to PCMCIA standards. And said memory card is for use with the memory card interface (36) which is provided to read the data from the memory card (120) (Bruns et al, figure 3, memory card 36). Brunts et al. teach that the memory card stores data regarding to a navigation destination (Bruns et al, column 7, lines 1-10) and said the memory card interface (36) is provided for reading the information stored in the memory card (Bruns et al, column 7, lines 50-65).

Bruns et al. do not disclose that the following limitation: "audio data assigned to the at least one navigation destination stored in the memory".

Art Unit: 3663

The reference to Nimura et al. has been cited as teaching a navigation system including an IC memory card (Nimura et al., column 8, lines 41-50) for storing various data such as destination data, voice guidance data, picture showing simple guide route that are necessary for navigation. Nimura et al. do not disclose that audio data assigned to the at least one navigation destination stored in the memory, however, the memory card, as set forth in column 8, lines 41-50, actually stores audio data and navigation destination, therefore Nimura et al. inherently disclose "audio data assigned to the at least one navigation destination stored in the memory".

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Brunts et al. to include the teachings as taught by Nimura et al. to gain advantage therefore (i.e., a driver can be capable of maintaining safety driving while reaching a selected destination).

The statement of intended use or field of use, "adapted to" clause is essentially method limitations or statements of intended or desired use. Thus, these claim as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

With regard to claim 12, Nimura et al. disclose that the audio data includes information about the navigation destination (Nimura et al., column 8, lines 41-50).

With respect to claim 13, Brunts et al. discloses a navigation method comprising: a card interface (36) provided to read the data from the memory card (120) (Bruns et al, figure 3, memory card 36). Brunts et al. teach that the memory card stores data regarding to a navigation destination (Bruns et al, column 7, lines 1-10) and said the memory card interface (36) is provided for reading the information stored in the memory card (Bruns et al, column 7, lines 50-65).

Bruns et al. do not disclose that the following limitation: "reading audio data assigned to the navigation destination from the memory of the navigation card".

The reference to Nimura et al. has been cited as teaching a navigation system including an IC memory card (Nimura et al., column 8, lines 41-50) for storing various data such as destination data, voice guidance data, picture showing simple guide route that are necessary for navigation. Nimura et al. do not disclose "reading audio data assigned to the navigation destination from the memory of the navigation card", however, the memory card, as set forth in column 8, lines 41-50, actually stores audio data and navigation destination, therefore Nimura et al. inherently disclose "reading audio data assigned to the navigation destination from the memory of the navigation card.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Brunts et al. to include the teachings as taught by Nimura et al. to gain advantage therefore (i.e., a driver can be capable of maintaining safety driving while reaching a selected destination).

With regard to claim 14, Brunts et al teach that the memory card interface (36) (Brunts et al., figure 3, memory card 36) for reading the information stored in the memory card (Brunts et al., column 7, lines 50-65). The voice data is reproduced via the audio speaker (65) (Brunts et al., figure 3).

With regard to claim 15, Brunts et al. inherently discloses the following: "the audio data is read and reproduced during navigational guidance" because during navigation guidance, the voice through the speaker (65) is produced for the purpose of navigating the driver traveling from a current location to a destination.

Response to Arguments

Applicant's arguments filed 12/05/2005 have been fully considered but they are not persuasive. The U.S. references to Brunts et al. and Nimura et al. still read on the claimed invention.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

Art Unit: 3663

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, *Brunts et al.* includes a memory card (120) which address the claimed navigation card, and that the memory card is inserted and read by the memory card interface (36). The memory card interface (36) directs to the key card reader as claimed (see *Brunts et al.*, column 12, lines 41-50). The second reference to *Nimura et al.* has been provided to overcome the missing feature from *Brunts et al.*, which is the “audio data assigned to the at least one navigation destination stored in the memory”. The data storage (37) described in *Nimura et al.* (*Nimura et al.*, column 8, lines 41-50) stores various data including audio data (*Nimura et al.*, column 8, line 45), and detail destination data (*Nimura et al.*, column 8, lines 43 and 44). For that reason the combination of *Brunts et al.* and *Nimura et al.* would be properly and therefore addresses the claimed limitation of the present invention.

Conclusions

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3663

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/tc

February 13, 2006


JACK KEITH
SUPERVISORY PATENT EXAMINER